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| EXAMINER | |
|---|---|
| OSELE, MARK A | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/813,873 | COSTELLO ET AL. | |
| | Examiner | Art Unit | |
| | Mark A. Osele | 1791 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, see pages 8-9, filed October 2, 2008, with respect to the rejection(s) of claim(s) 1-24 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Travers et al. or Shibuya et al.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Travers et al. (U.S. Patent 6,129,264). Travers et al. shows a method of printing a moving substrate, comprising: supplying a moving substrate to a first converting operation (first printing); contact printing at least one first graphic, 21, 22, on the moving substrate; supplying the moving substrate with the graphic to a second converting operation (second printing): and non-contact printing at least one second graphic, 23, on the moving substrate (Column 1, lines 32-34; Column 3, lines 4-14; Column 7, lines 10-37).

Regarding claim 2, the contact printing utilizes a flexographic printer.

Regarding claim 3, the non-contact printing utilizes an ink jet printer.

Regarding claim 4, the first and second graphics jointly form a story line.

Regarding claim 10, the first and second graphics jointly form a master graphic (Fig. 1, element 11).

Regarding claims 22 and 24, the second graphics are names and addresses are intended customers of the individualized mailing and the articles are distributed to customers through the mail (Column 1, lines 6-32).

4. Claims 1-4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibuya et al. (U.S. Patent 5,906,156). Shibuya et al. shows a method of printing a moving substrate, comprising: supplying a moving substrate to a first converting operation (first printing); contact printing at least one first graphic on the moving substrate; supplying the moving substrate with the graphic to a second converting operation (second printing): and non-contact printing at least one second graphic on the moving substrate (Column 4, lines 46-55).

Regarding claim 2, the contact printing utilizes an offset printer (Column 5, lines 56-59; Column 6, lines 16-18).

Regarding claim 3, the non-contact printing utilizes an ink jet printer.

Regarding claim 4, the first and second graphics jointly form a story line (Column 6, lines 40-44).

Regarding claim 10, the first and second graphics jointly form a master graphic (Column 6, lines 40-44).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Travers et al. or Shibuya et al. in view of Matkan (U.S. Patent 4,176,406). As shown in paragraphs 3 and 4 above, Travers et al. and Shibuya et al. each show the claimed invention except for the speed of the moving substrate. Matkan teaches that ink jet printing can be performed on webs moving at 800 ft/minute (column 4, lines 48-52). It would have been obvious to one of ordinary skill in the art at the time of the invention to print the graphics of Travers et al. or Shibuya et al. at speeds greater than 100 ft/minute because Matkan shows this to be well within the effective range of ink jet printers and because faster speeds create faster throughput and productivity.

7. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibuya et al. in view of Cammarota et al. (U.S. Patent 6,307,119). As shown in paragraph 4 above, Shibuya et al. shows the limitations of independent claim 1 from which claims 6 and 9 depend.

Regarding claims 6 and 9, the method of Shibuya et al. further includes non-contact printing a third graphic (Column 9, lines 56-64) but fails to show the third graphic

overprinting the first graphic. Cammarota et al. shows printing a plurality of graphics, 66, 81, 85, 92, 96, 97, on a web wherein graphic 85 is overprinted on graphic 92 (column 17, lines 44-64; Fig. 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to overprint the third graphic of Shibuya et al. on the first graphic because Cammarota et al. teaches that it is sometimes desirable to print a background graphic and overprint a foreground graphic thereon.

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al. (U.S. Patent 5,766,389) in view of either Travers et al. or Shibuya et al. Brandon et al. teaches, a method of printing a moving substrate comprising: supplying a moving substrate (figure 5, moving substrate '66,') to a first converting operation (figure 5, moving substrate '66,' and column 2, lines 24-32, and column 13, lines 15-19); printing (column 12, lines 25-27) at least one first graphic on the moving substrate (figure 1, registered graphic '38'); supplying the moving substrate with the first graphic (registered graphic '38') to a second converting operation (column 2, lines 32-35); and printing (column 12, lines 25-27) at least one second graphic on the moving substrate [column 6, lines 49-51, (a plurality of distinct and separate graphics)].

Brandon et al. fails to objectively teach contact printing utilizing a gravure printer, flexographic printer, offset printer, or screen printer followed by non-contact printing utilizing a wax jet printer, ink jet printer, laser jet printer, or bubble jet printer (column 9, lines 7-10). Travers et al. and Shibuya et al. each teach non-contact printing a first graphic on a moving web followed by non-contact printing a second graphic on the

moving web. (Travers et al.: Column 1, lines 32-34; Column 3, lines 4-14; Column 7, lines 10-37; Shibuya et al.: Column 4, lines 46-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to use contact printing followed by non-contact printing in the method of Brandon et al. because Travers et al. teaches that variable graphics are more easily changed using non-contact printing so the use of contact printing can print non-variable graphics while downstream non-contact printing can print variable graphics depending on the product being made (column 3, lines 4-14, Column 7, lines 10-37). In addition, Shibuya et al. teaches that non-contact printing devices can be easily added on to manufacturing lines already using a contact printing device cheaply and quickly (column 3, lines 40-53, 62-67).

Regarding claims 7 and 8, Brandon et al. teaches wherein the second converting operation produces disposable absorbent articles and the moving substrate forms an outer cover (column 11, lines 20-28, outer cover '34') of the articles (column 4, lines 43-55 and column 12, lines 47-58), and the moving substrate forms a bodyside liner or an absorbent of the articles (figures 3 and 4, absorbent pad '32').

9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al. in view of Travers et al. or Shibuya et al. as applied to claims 7-8 above, and further in view of Yeo (U.S. Patent 5,503,076). Yeo also shows making a laminated absorbent garment including printing wherein the substrate is a laminate comprising a film layer (column 10, lines 39, polyethylene film) and a nonwoven layer (column 10, lines 40-41, polypropylene spunbonded web) and the first graphic is printed on the film

layer and the second graphic is printed on the nonwoven layer (column 8, lines 42-48); or wherein the substrate is a laminate comprising a film layer and a nonwoven layer and the first graphic is printed on the nonwoven layer and the second graphic is printed on the nonwoven layer (column 3, lines 33-43); or wherein the substrate is a laminate comprising a film layer and a nonwoven layer and the first graphic is printed on the film layer and the second graphic is printed on the film layer (figure 2, adhesive inks '16,' figure 3, and example 1, column 10, lines 39-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to print the first and second graphics of the method of the references as combined on any combination of the non-woven layer and film layer, whichever is desired by the manufacturer, distributor, or customer, because Yeo teaches that these are all functionally equivalent alternate expedients.

Claims 14-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al. in view of Travers et al. or Shibuya et al. and Yeo as applied to claims 11-13 above, and further in view of Olson et al. (U.S. Patent 6,297,424). The references as combined fail to show the claimed location of the graphics.

Olson et al. shows a method of making an absorbent article with printing thereon wherein the first graphic spanning at least 60% of the width of the outer cover and being visible to the naked eye, the second graphic being positioned within the center third of the width of the outer cover and being visible to the naked eye (Olson, figures 5 and 6, clearly indicate several graphics ('92,' '94,' '96,' and '100') which span at least 60% of the width of the outer cover and being visible to the naked eye). It would have

been obvious to one of ordinary skill in the art at the time of the invention to place the graphics of method of the references as combined in the positions shown by Olson et al. to permit better visibility of the graphic for the wearer and to improve appearance of the absorbent article.

Regarding claims 15 and 16, Olson et al. further teaches the absorbent article has a front waist region, a back waist region, and a crotch region connecting the front waist region and the back waist region, and the second graphic is positioned within the front waist region or the back waist region (figures 5 and 6).

Regarding claim 17, Olson et al. teaches, the absorbent article to have a front waist region, a back waist region, and a crotch region connecting the front waist region and the back waist region, further comprising two or more second graphics, at least one second graphic positioned within the front waist region and at least one second graphic positioned within the back waist region [figures 1-6, (the examiner notes that there are several graphics depicted within figures 1-6, it would have been obvious to one of ordinary skill in the art at the time of the invention to position the graphics on either the front waist region, back waist region, or both according to the final appearance desired, as taught by Olson), (column 7, line 48 thru column 8, line 34, particularly column 8, lines 7-17)].

10. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al. in view of Travers et al. or Shibuya et al. as applied to claims 7-8 above, and further in view of Odorzynski (U.S. Patent Publication 2005/0149389) and

Cammarota et al. The references as combined fail to show printing advertising on the absorbent garment.

Odorzynski teaches that advertising can be printed on absorbent garments (paragraphs 23, 29). It would have been obvious to one of ordinary skill in the art at the time of the invention to add advertising to the absorbent garment of the references as combined because Odorzynski teaches that advertising on absorbent garments creates additional revenue (paragraphs 004-009). Furthermore, any known advertising technique, including absence advertisements, would be envisioned by one of ordinary skill in the art from the disclosure of Odorzynski which teaches a wide array of advertising techniques and suggest that others are possible (paragraphs 0023, 0027-0034).

Cammarota et al. shows printing a plurality of graphics, 66, 81, 85, 92, 96, 97, on a web wherein graphic 85 is overprinted on graphic 92 (column 17, lines 44-64; Fig. 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to overprint graphics of the method of the references as combined because Cammarota et al. teaches that it is sometimes desirable to print a background graphic and overprint a foreground graphic thereon.

Regarding claim 19, Odorzynski further teaches a contest as part of the advertising ((paragraphs 0030-0031).

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Travers et al. As shown in paragraph 3 above, Travers et al. shows the claimed limitation

except for the use of different languages in the printing. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the language of the mass mailing dependent upon which country the mailing is intended so that the residents of that country can read the mailing.

### *Response to Arguments*

12. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark A Osele/
Primary Examiner, Art Unit 1791
January 21, 2009